

**IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS
TEXARKANA DIVISION**

MAXELL, LTD.,

Plaintiff,

v.

SAMSUNG ELECTRONICS CO., LTD. and
SAMSUNG ELECTRONICS AMERICA,
INC.,

Defendants.

Civil Action No. 5:23-cv-00092-RWS

JURY TRIAL DEMANDED

**SAMSUNG'S MOTION FOR SUMMARY JUDGMENT
OF NON-INFRINGEMENT OF U.S. PATENT NO. 10,176,848**

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EXHIBITS

Ex.	Description
A	U.S. Patent No. 10,176,848 (“’848 patent”)
B	U.S. Patent No 10,176,848 Ex Parte Reexamination Certificate
C	Excerpts from ’848 patent Rebuttal Report of Dr. Kia (dated Dec. 9, 2024)
D	Excerpts from ’848 patent Opening Report of Dr. Balakrishnan (dated Nov. 5, 2024)
E	Excerpts from the Deposition Transcript of Dr. Balakrishnan (dated Dec. 18, 2024)
F	IPR2024-00867, Patent Owner Preliminary Response (dated Aug. 12, 2024)
G	Excerpts from ’848 patent Reexamination File History

I. INTRODUCTION

The Samsung defendants move for summary judgment that the asserted claims of U.S. Patent No. 10,176,848 are not infringed. Undisputed facts establish that the accused Samsung products do not practice at least one claim limitation of each of asserted claims 11, 12, and 84, and summary judgment is thus warranted on those claims.

II. STATEMENT OF THE ISSUES TO BE DECIDED BY THE COURT

1. Whether the accused Samsung products infringe asserted claims 11, 12 and 84 of the '848 patent when they do not “register a person... as a specific person” in a “first setting mode.”

2. Whether the accused Samsung products infringe asserted claims 11 and 12 of the '848 patent when the accused reproducing modes reproduce different image information rather than the same image information.

3. Whether the accused Samsung products infringe asserted claim 84 of the '848 patent when they do not display “video image data.”

III. STATEMENT OF UNDISPUTED MATERIAL FACTS

UMF1: The '848 patent asserted claims recite a recording and reproducing apparatus (*e.g.*, a video camera) that registers a person as a specific person using two selectable setting modes, as shown in claim limitations [8g], [8h], [84c.v], and [84c.vi]. Ex. A, claim 8 (on which asserted claims 11 and 12 depend) at 15:64-16:7; Ex. B, claim 84 at 8:57-9:5.

UMF2: Maxell's evidence that the Samsung representative products meet the “setting mode” limitations relies on the initial registration of a person as a specific person in the alleged “second setting mode” via creating a “tag” or an “auto-updating album” for that person. Ex. D ¶¶ 75, 251-52, 514-15; Ex. E at 64:24-66:18, 68:10-69:20.

UMF3: Maxell's evidence that the Samsung representative products meet the “first setting mode” limitations relies on newly capturing an image of a person who has already been registered

in the alleged “second setting mode” and then observing the newly captured image being assigned the “tag” or sorted into the “auto-updating album” that has already been created for that person. Ex. D ¶¶ 75, 254-55, 517-18; Ex. E at 69:21-70:12, 72:10-74:7.

UMF4: Maxell informed the PTAB during IPR proceedings that, in the ’848 patent limitations directed to the “first setting mode” limitations, “it is not until after the new person is photographed that the new person is registered as the specific person.” Ex. F at 33.

UMF5: Maxell used this characterization of the limitations to the PTAB to distinguish a prior art device that, according to Maxell, “only captures a photograph after the person’s registration information is inputted,” which Maxell argued to the PTAB does not meet the first setting mode claim limitations. Ex. F at 33.

UMF6: Claims 11 and 12 recite “reproduction of the image information in a reproducing mode set from one of” a recited “first,” “second,” and “third” reproducing modes, wherein the reproducing modes have, among other things, different “reproducing times” for “the image information,” which constitutes “a photograph” as recited in underlying claim 8. Ex. A.

UMF7: Maxell’s evidence that the accused “slideshow,” “highlight reel,” and “movie” functionalities in the Gallery applications of the accused Samsung products constitute the claimed “reproducing modes” relies on the reproduction of different photographs for each alleged “mode.” Ex. D ¶¶ 303, 309-10, 365; Ex. E at 94:22-95:11, 43:10-44:12; Ex. C ¶ 57.

UMF8: Claim 84, limitation [84e], recites “a video camera providing video image data, wherein, in response to the face-recognizing process recognizing that a face of a person is included in the video image data, the display displays the video image data with a frame surrounding at least a portion of the face of the person.” Ex. B, claim 84, 9:15-20.

UMF9: [REDACTED]

Ex. D ¶ 608; Ex. E 124:22-126:16, 126:18-129:22, 134:5-136:2, 136:25-137:6, 139:16-20, 140:5-20.

IV. LEGAL STANDARDS

“The court shall grant summary judgment if the movant shows that there is no genuine dispute as to any material fact and the movant is entitled to judgment as a matter of law.” Fed. R. Civ. P. 56(a). An issue of material fact is genuine only if the evidence could lead a reasonable jury to find for the nonmoving party. *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248 (1986). All factual inferences are drawn in the light most favorable to the nonmoving party. *Id.* Summary judgment must be granted if the nonmoving party fails to establish an element essential to its case on which it bears the burden of proof. *Celotex Corp. v. Catrett*, 477 U.S. 317, 322-23 (1986).

V. ARGUMENT

The ’848 patent is directed to a device that identifies and registers people in video, segments video into chapters for easier navigation, and selectively reproduces the video information showing the registered people. Ex. A at Abstract. The ’848 patent originally issued with 20 claims. *Id.* (Cover). However, a reexamination in 2020 resulted in the cancellation of claims 8, 10, 13, 15, and 18 and the issuance of new claims 21-84. Ex. G at 2. Maxell currently asserts claims 11 and 12—which depend from cancelled claim 8—and new claim 84. Ex. A at claims 11, 12; Ex. B at claim 84. For each of the three independent reasons set forth below, undisputed evidence establishes that Samsung does not infringe any of the three asserted claims.

A. Claims 11, 12 and 84 are not infringed—no “first setting mode”

The first independent reason the accused products do not infringe the three asserted claims is that the claims require “register[ing] a person in the image information as a specific person” in one of two selectable modes. In the “first setting mode,” a person is “newly photograph[ed]” and the image information from the newly captured photo is thereafter used to register the person as

“the specific person.” Ex. A, claim 8 at 15:66-16:2; Ex. B, claim 84 at 8:59-65. The “second setting mode” requires selecting a person from a plurality of people whose faces appear in image information that already has been recorded in the recording medium, and the image information of the selected person is used to register the selected person as “the specific person.” Ex. A, claim 8 at 16:3-7; Ex. B, claim 8 at 8:65-9:5. The parties agree that the limitations in claims 8 (on which claims 12 and 14 depend) and 84 are substantively similar, and Maxell’s infringement analysis is the same for each. Ex. E at 46:25-48:13.

The accused products do not have the claimed “first setting mode” because Maxell identifies only one mode of registering a person as “the specific person” and that mode corresponds only to the “second setting mode” limitation. What Maxell asserts meets the “first setting mode” is not registering a person, as the claims require, but rather is sorting a newly taken photograph of a person that has *already been registered* under the “second setting mode.”

1. The accused Gallery application allows a user to register a person under Maxell’s identified “second setting mode”

Maxell accuses the Gallery application, which is an application for managing photographs and videos in the accused products. Maxell points to two ways of registering a person as a specific person in the Gallery application: (1) creating a “tag” for a specific person in one or more photographs that are *already* in the Gallery application (Ex. D ¶¶ 251, 514); and (2) creating an “auto-updating album” for a specific person in one or more photographs *already* in the Gallery application (*id.* ¶¶ 252, 515). Notably, Maxell contends both these methods are the “second setting mode” of the asserted claims. *Id.* ¶¶ 251-252, 514-515.

For the first of these two methods, Maxell points to the user selecting an image in the Gallery application and then selecting “# Add Tag” and “?” to register the person in the image as a specific person. Ex. D ¶¶ 251, 514. For the second method, Maxell points to the user selecting

[REDACTED]

an option in the Gallery application to create an “auto-updating album” and then selecting a person in an already-taken photograph to be registered as the specific person associated with that album name. *Id.* ¶¶ 252, 515. Significantly, Maxell’s expert confirmed in deposition that [REDACTED]

[REDACTED]

[REDACTED] Ex. E at 64:24-66:18 ([REDACTED]), 68:10-69:20 ([REDACTED]).

2. What Maxell points to as the “first setting mode” in the Gallery application does not register a person and thus cannot infringe

Critically, it is only after the registration of a person is completed using the “second setting modes” described above that the functionality Maxell asserts meets the “first setting mode” becomes operative. Specifically, according to Maxell, “taking a new photograph” of the registered person “will automatically include the new recorded image under that person’s tag [] through use of the face-recognition processing.” Ex. D ¶¶ 254, 517. Maxell includes similar allegations for an “auto-updating album” theory, alleging that “the new recorded image” appears “under that person’s album.” *Id.* ¶¶ 255, 518.

Maxell’s infringement theory fails on its face because the “first setting mode” Maxell identifies is not a mode of registering a person as a specific person as the claims require because that person already has been registered under the second setting mode. When asked about the alleged “first setting mode” in deposition, Maxell’s expert conceded that b [REDACTED]

[REDACTED]

[REDACTED] Ex. E at 69:21-70:12. [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] *Id.* at 72:10-74:7. In neither case is the person being registered as “the specific person” as the claimed “first setting mode”

requires because that person already has been registered in what Maxell identifies as the “second setting mode.” These facts are further demonstrated by the “testing protocol” of Maxell’s own expert, which involved capturing images of different people on day 1, setting up the “tag” or “auto-updating album” for one of the people in the photos (identified as “Hawah”) on day 2, and then—only after those steps have been taken and the person already has been registered—taking “an additional photo of Hawah” and observing “that the additional photo is recognized as Hawah,” who is the person who has already been registered. Ex. D ¶ 75.

3. Maxell’s unsupported assertion that the Gallery application satisfies the “first setting mode” limitation is undercut by its prior statements to the PTAB

Maxell’s “first setting mode” infringement theory limitation also is contradicted by its prior statements to the PTAB in IPR proceedings for the ’848 patent. In its Patent Owner Preliminary Response (POPR), Maxell distinguished the “first setting mode” in the cited Nozaki prior art—which operated in the same way as Maxell’s infringement theory in the present case—as “operat[ing] in precisely the opposite manner as the claimed invention”:

Thus, Nozaki operates in precisely the opposite manner as the claimed invention, namely “when the first setting mode is selected, a person with a face is obtained by **newly photographing the person** in a photographing mode **and thereafter** registered as the specific person.” Claim 8 (emphasis added). In other words, it is not until after the new person is photographed that the new person is registered as the specific person. Nozaki, as admitted by Petitioner, only newly captures a photograph after the person’s registration information is inputted.

Ex. F at 33. Maxell’s current infringement theory mirrors the very features of Nozaki that Maxell distinguished in its POPR because Maxell’s current theory also involves “only newly captur[ing] a photograph after the person’s registration information is inputted.” Maxell’s infringement theory is thus not only factually baseless and contrary to the express claim language, it is additionally precluded as a matter of law. *See Aylus Networks, Inc. v. Apple Inc.*, 856 F.3d 1353, 1364 (Fed. Cir. 2017) (affirming a finding of noninfringement based on contrary positions taken by Patent

Owner in an IPR preliminary response).

Accordingly, Maxell has failed to show that the accused products infringe asserted claims 11, 12 and 84 because the products do not meet the “first setting mode” claim limitations.

B. Claims 11 and 12 are not infringed—no “reproducing modes” for “the image information”

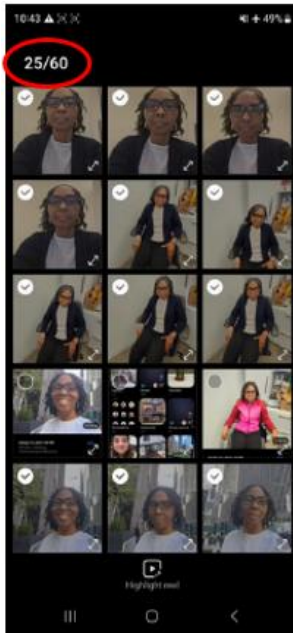
The second independent reason the accused products do not infringe claims 11 and 12 is that the claims require “reproduction of the image information in a reproducing mode set from one of” a recited “first,” “second,” and “third” reproducing modes. Ex. A at claims 11 and 12 (emphasis added). Given the use of the word “the” in the claim phrase “the image information,” the first, second, and third reproducing modes recited in claims 11 and 12 must be reproducing *the same* “image information” recited in underlying claim 8 because it is claim 8 that provides the necessary antecedent basis for “the image information” in claims 11 and 12. *Id.*, claim 8 at 15:57-59. Claim 8 also recites that the “image information” comprises “a photograph.” *Id.*

Notwithstanding that the claim clearly requires that the same “image information” (*i.e.*, the same photograph) be used in each of the three claimed reproducing modes, Maxell’s infringement theory relies on functionality in the Gallery application that uses *different* sets of photographs for each alleged reproducing mode. This cannot infringe claims 11 or 12 as a matter of law.

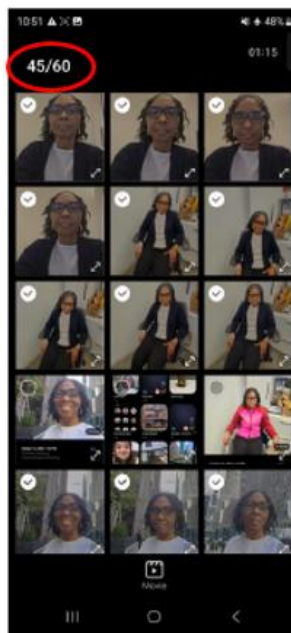
Maxell exclusively accuses the “slideshow,” “highlight reel,” and “movie” functionalities in the Gallery applications as constituting the claimed reproducing modes. *See, e.g.*, Ex. D ¶ 303. Maxell’s infringement theory, however, does not rely upon the same image information being reproduced in the three purported modes. Rather, Maxell uses different photographs. For example, as shown below, Maxell’s infringement evidence for the Galaxy S23 Ultra representative product relies on: (1) for a first reproducing mode, a highlight reel created from a selection of 25 photographs in the “Hawah” album; (2) for a second reproducing mode, a movie created from 45

photographs in the same album; and (3) for an additional reproducing mode (either as an alternative second reproducing mode for claim 11 or as a third reproducing mode for claim 12), a slideshow created from 98 photographs in that same album.

Highlight Reel Image Selection



Movie Image Selection



Slideshow Image Selection



Ex. D (Balakrishnan Rpt.) ¶¶ 310, 365 (red circles added to highlight the image information used to generate the Galaxy S23 Ultra highlight reel, movie and slideshow). Maxell's expert confirmed that [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

Ex. E at 94:22-95:11.

Maxell's infringement theory therefore fails as a matter of law. It is well-settled that the "use of the definite articles 'the' or 'said' in a claim refers back to the same term recited earlier in the claim," and that each reference to that term should be understood as a reference to the same thing. *See Wi-LAN, Inc. v. Apple Inc.*, 811 F.3d 455, 462 (Fed. Cir. 2016) (holding that recitation of "the modulated data symbols" in a limitation refers back to the "same" data symbols produced in an earlier claim element). Applying this black letter law to claims 11 and 12, the first, second, and third reproducing modes recited in claims 11 and 12 must be reproducing the same "image information" recited in the underlying claim 8, which comprises "a photograph." Indeed, both experts agree a POSITA would read claims 11 and 12 to require reproducing the same image information. Ex. E at 43:10-44:12; Ex. C ¶ 57.

Accordingly, because the movies, slideshows, and highlight reels created by Maxell on the representative accused products consist of *different* photographs (*i.e.*, different "image information") in each purported "mode," Maxell fails to show that claims 11 and 12 are infringed.

C. Claim 84 is not infringed—no "video image data"

A second independent reason the accused products do not infringe claim 84 is that the claim requires "a video camera providing *video image data*, wherein, in response to the face-recognizing process recognizing that a face of a person is included in *the video image data*, the display displays *the video image data* with a frame surrounding at least a portion of the face of the person." Ex. B, claim 84 at 9:15-20 (emphasis added). Consistent with this limitation's plain language, Maxell's expert [REDACTED]

[REDACTED] Ex. E at 134:5-23 (emphasis added). Samsung's accused products do not meet this limitation because [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] which is the sole feature Maxell accuses for this limitation.

Maxell contends the Galaxy S23 representative product meets this limitation because, in the preview of the Camera application while in photo mode, a frame surrounds a portion of a face of a person when the face is recognized in the on-screen image data, as shown in the image below from Maxell's expert report:



Ex. D ¶ 608; Ex. E at 134:24-136:2, 136:25-137:6.

This infringement theory fails because Maxell's expert unequivocally conceded during deposition that t [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

Ex. E at 139:16-20, 140:5-20; *see also id.* at 124:22-126:16, 126:18-129:22 [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

Because it is undisputed that the camera application is not displaying “video image data” when showing a preview image while in photo mode, Maxell has failed to prove that this claim limitation is practiced. Specifically, the camera application, while in photo mode, is not “providing video image data,” and as a result any face-recognizing process cannot be “recognizing that a face of a person is included in the video image data,” nor can the display be “display[ing] the video image data with a frame surrounding at least a portion of the face of the person.” The accused products therefore do not infringe claim 84 for this additional independent reason.

VI. CONCLUSION

For the foregoing reasons, summary judgment of non-infringement should be granted on the asserted claims of the '848 patent.

Dated: January 14, 2025

Respectfully submitted,

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[REDACTED]

CERTIFICATE OF SERVICE

I hereby certify that on January 14, 2025, a true and correct copy of the above and forgoing document has been served by electronic mail on all counsel of record.

/s/ Melissa R. Smith
Melissa R. Smith

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]